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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,014	01/18/2006	Gerald Hobisch	11885-00075-US	5437
23416 7590 05/19/2009 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899				
EXAMINER				
DOLLINGER, MICHAEL M				
ART UNIT		PAPER NUMBER		
1796				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,014

Applicant(s)

HOBISCH ET AL.

Examiner

MICHAEL DOLLINGER

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworak et al (US 2002/0077389 A1).
4. Dworak et al disclose aqueous binder mixtures comprising and their use in water-dilutable primer surfacers for automobiles finishing comprising condensation product AB of hydroxyl group-containing resins B and water-soluble or water-dispersible resins A containing acid groups [0010] and pigments [0032]. The condensation products AB preferably have an acid number of from 25 to 75 mg/g and are prepared using the components A and B in a mass ratio of from 10:90 to 80:20, preferably 15:85 to 40:60 [0015]. The resins A may be acidic acrylate resins A5 with an acid number from 100 to 230 mg/g and in particular 70 to 160 mg/g [0016]. The acrylate resins A5 may be

copolymerized from monomers A51 olefinically unsaturated carboxylic acids such as acrylic acid (which read on the claimed monomer A1), monomers A52 which are other vinyl or acrylic monomers such as alkyl esters of acrylic and methacrylic acids (which read on the claimed monomer A2), and optionally monomers A53 which include lactones with unsaturation (which also read on the claimed monomer A2) [0022].

Dworak et al do not disclose amounts of the monomers of A5, but one would readily envisage a compound A5 consisting of monomers in the ratio A51/A52/A53 of 33%/33%/33%, since A52 and A53 read on the claimed monomer A2 and A51 reads on the claimed monomer A1 this ratio would result in a mixture of A1 and A2 monomers with 33% A1 contained therein. The resins B may be polyesters B1 with a hydroxyl number from 70 to 300 mg/g [0024]. This may be achieved by using polyhydric alcohols containing on average at least two, preferably at least 2.1, hydroxyl groups per molecule, with dicarboxylic acids or with a mixture of polycarboxylic and monocarboxylic acids containing on average not more than two, preferably from 1.5 to 1.95, acid groups per molecule [0025]. The production examples polyesters BI and BII include branched and straight chain aliphatic diols reacted with polycarboxylic acids and fatty acids [0047-0050]. In the inventive examples 1-3, the pigment titanium dioxide is used an amount of 43.3 to 44 g of titanium dioxide to 100 g of condensation resin AB [Tables 2 and 3; 0060].

5. Regarding the limitation requiring that the hydroxy functional polyesters be hydrophobic, Dworak et al teach that the polyesters are hydrophilicized by modification of acids [0009]. Presumably, the polyesters lacking modified carboxylic acid groups will

be hydrophobic. Furthermore, hydrophobicity is an inherent property of a compound or polymer. Since Dworak et al teach the same composition as claimed, the hydrophobicity of the hydroxyl function polyester composition would inherently be the same as claimed. If there is any difference between the product of Dworak et al and the product of the instant claims the difference would have been minor and obvious.

"Products of identical chemical composition can not have mutually exclusive properties."

A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. See MPEP 2112.01(I) , *In re Best*, 562 F2d at 1255, 195 USPQ at 433, *Titanium Metals Corp v Banner*, 778 F2d 775, 227 USPQ 773 (Fed Cir 1985), *In re Ludtke*, 441 F2d 660, 169 USPQ 563 (CCPA 1971) and *Northam Warren Corp v D F Newfield Co*, 7 F Supp 773, 22 USPQ 313 (EDNY 1934).

6. Regarding claim 6, case law holds that the selection of any order of mixing ingredients is *prima facie* obvious. *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930).

7. Dworak et al do not disclose the molar mass of polyesters B1. However, Dworak et al do disclose the molecular weight of hydroxyl group containing polyurethane resins B3, an alternative to the polyesters B1 in condensation product B. Dworak et al disclose that the polymeric polyols B31, reacted with isocyanates B32 to make polyurethane B3, have a number average molar mass of from about 200 to 10,000 g/mol [0027]. Since polymeric polyols B31 make up the bulk of the hydroxyl group containing polyurethane B3 and since B3 and B1 have the same hydroxyl and acid

numbers (which depend on molar mass), one having ordinary skill in the art would have used the molar mass for the B31 polymeric polyols in determining the molar mass appropriate for the polyester B1.

Response to Arguments

8. Applicant's arguments, see pages 5-6, filed 03/23/2009, with respect to Kadambande (US 6,627,700 B2) have been fully considered and are persuasive. The rejection of 12/22/2008 has been withdrawn.
9. Applicant's arguments filed 03/23/2009 with respect to Dworak et al (US 2002/0077389 A1) have been fully considered but they are not persuasive. Applicant argues that the hydroxy functional polyesters B of Dworak et al are not hydrophobic and do not comprise a monofunctional aliphatic carboxylic acid which is a fatty acid. These arguments are not convincing because the inventive examples comprise fatty acids [0047-0050] and the hydrophobicity of the polyesters are addressed in the revised rejection above.
10. Applicant's arguments, see pages 7-9, filed 03/23/2009, with respect to Buter (US 2002/0016407 A1) have been fully considered and are persuasive. The rejection of 12/22/2008 has been withdrawn.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MICHAEL DOLLINGER** whose telephone number is (571)270-5464. The examiner can normally be reached on Monday - Thursday 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796

MICHAEL DOLLINGER
Examiner
Art Unit 1796

/mmd/